



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,522	10/07/2003	Ravi Kuchibhotla	CS23738RL	5055
20280	7590	04/22/2008		
MOTOROLA INC 600 NORTH US HIGHWAY 45 W4 - 39Q LIBERTYVILLE, IL 60048-5343			EXAMINER GARY, ERIKA A	
			ART UNIT 2617	PAPER NUMBER
			NOTIFICATION DATE 04/22/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DOCKETING.LIBERTYVILLE@MOTOROLA.COM
ADB035@Motorola.com

Office Action Summary	Application No. 10/680,522	Applicant(s) KUCHIBHOTLA ET AL.	
	Examiner Erika A. Gary	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 18-24 is/are allowed.
- 6) ☒ Claim(s) 14-16, 25-28, 30 and 32-35 is/are rejected.
- 7) ☒ Claim(s) 17, 29 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 27-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no support in the specification for a computer readable medium.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 27-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for a wireless communications system information message, broadcast message, or connection request message stored on a computer-readable medium.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 14-16, 25, and 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Mildh et al., US Patent Application Publication Number 2002/0193139 (hereinafter Mildh).

Regarding claim 14, Mildh discloses a method in a communication device, the method comprising: receiving system information, the system information including pointer information indicating where the communication device may obtain information about multiple core networks sharing a common access network from which the system information was received; attempting to connect to one of the multiple core networks using the information about multiple core networks sharing the common access network from which the system information was received [paragraphs 0009-0010, 0014-0019].

Regarding claim 15, Mildh discloses selecting the one of the multiple core networks to which the communication device attempts to connect using the information about multiple core networks sharing the common access network from which the system information message was received [paragraph 0018].

Regarding claim 16, Mildh discloses obtaining an identity for the core network to which the communication device attempts to connect using the pointer information [paragraph 0016].

Regarding claim 25, Mildh discloses a method in a communication device, the method comprising: receiving information about multiple core networks sharing a common access network, the information including at least one of identities of at least some of the multiple core networks sharing the common access network, core network domain information, information on services supported by at least some of the multiple core networks sharing the common access network; selecting a core network to which the communication device attempts to connect using the information received [paragraphs 0009-0010, 0014-0019].

Regarding claim 34, Mildh discloses a method in a communications network entity, the method comprising: receiving preferred core network information from a communication device; selecting a core network for the communication device; giving consideration to the preferred core network information received from the communication device when selecting the core network for the communication device [paragraphs 0009-0010, 0014-0019, 0035-0039].

Regarding claim 35, Mildh discloses receiving the at least one preferred core network from a communication device in a connection request from the communication device [paragraph 0035].

7. Claims 14-16, 25, 27, 28, 30, 32, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Costa et al., US Patent Number 7,280,516 (hereinafter Costa).

Regarding claim 14, Costa discloses a method in a communication device, the method comprising: receiving system information, the system information including pointer information indicating where the communication device may obtain information about multiple core networks sharing a common access network from which the system information was received; attempting to connect to one of the multiple core networks using the information about multiple core networks sharing the common access network from which the system information was received [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5].

Regarding claim 15, Costa discloses selecting the one of the multiple core networks to which the communication device attempts to connect using the information about multiple core networks sharing the common access network from which the system information message was received [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5].

Regarding claim 16, Costa discloses obtaining an identity for the core network to which the communication device attempts to connect using the pointer information [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5].

Regarding claim 25, Costa discloses a method in a communication device, the method comprising: receiving information about multiple core networks sharing a common access network, the information including at least one of identities of at least some of the multiple core networks sharing the common access network, core network

domain information, information on services supported by at least some of the multiple core networks sharing the common access network; selecting a core network to which the communication device attempts to connect using the information received [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5].

Regarding claim 27, Costa discloses a wireless communications system information message modulated on a radio frequency carrier, the communications system information message comprising: an information block, the information block including a data field for a number indicating how many core networks share a common access network received [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 6: lines 37-39].

Regarding claim 28, Costa discloses the information block is a core network-identifying portion of the system information message [col. 5: lines 56-59].

Regarding claim 30, Costa discloses a wireless communications system information message modulated on a radio frequency carrier, the communications system information message comprising: an information block, the information block including a pointer to a location where identities for multiple wireless communications core networks sharing a common access network may be obtained [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 6: lines 37-39].

Regarding claim 32, Costa discloses a wireless communications system information broadcast message modulated on a radio frequency carrier, the communications system information broadcast message comprising an information block, the information block including a pseudo network identity identifying multiple core

networks sharing a common access network [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 6: lines 37-39].

Regarding claim 33, Costa discloses a wireless network connection request message modulated on a radio frequency carrier, the network connection request message comprising: an information block, the information block including a data field for indicating that a network entity may select, on behalf of a communication device, one of a plurality of core networks sharing a common access network [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 6: lines 37-39].

8. Claims 25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Haumont et al., US Patent Application Publication Number 2004/0258019 (hereinafter Haumont).

Regarding claim 25, Haumont discloses a method in a communication device, the method comprising: receiving information about multiple core networks sharing a common access network, the information including at least one of identities of at least some of the multiple core networks sharing the common access network, core network domain information, information on services supported by at least some of the multiple core networks sharing the common access network; selecting a core network to which the communication device attempts to connect using the information received [paragraphs 0006, 0018, 0038, 0041, 0043].

Regarding claim 26, Haumont discloses receiving the information in response to an unsuccessful core network connection attempt [paragraphs 0048, 0054].

Allowable Subject Matter

9. Claims 1-13 and 18-24 are allowed, as indicated in the previous office action.
10. Claims 17, 29, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed 2/5/08 have been fully considered but they are not persuasive. Regarding claims 14-26, 25, and 34-36, the Examiner maintains that Mildh discloses the claimed limitations. Applicant argues that Mildh does not teach pointer information indicating where the communication device may obtain information about core networks. However, Mildh teaches this limitation in the disclosure of the SI and/or PSI message telling the mobile station which core network it should camp on. Applicant also argues that Mildh does not teach receiving preferred core network information from a communication device. However, the Examiner respectfully disagrees and contends that this is taught in paragraphs 0035-0039.

Regarding the claims 14-16, 25, 27-28, 30, and 32-33, the Examiner maintains that Costa teaches the claimed limitations. Applicant argues that Costa does not teach pointer information indicating where the communication device may obtain information about multiple core networks. However, Costa teaches this limitation in the disclosure

of a core network identifier field that distinguishes between two different core networks [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5]. Costa also teaches that if two core networks are accessible from the location area, an appropriate range of values are provided by the core network identifier [col. 6: lines 37-39]. Hence Costa also teaches obtaining information about multiple core networks, as contended by the Applicant. Applicant also argues that Costa does not teach selecting a core network. However, the Examiner respectfully disagrees as the purpose of Costa's invention is "core network allocation".

Regarding claims 25 and 26, the Examiner maintains that Haumont teaches the claimed limitations. Applicant argues that Haumont does not teach a communication device that receives information including at least one of identities of at least some of the multiple core networks sharing the common access network, core network domain information, information on services supported by at least some of the multiple core networks sharing the common access network. However, the Examiner respectfully disagrees, and maintains that Haumont teaches this limitation as only one set of information is required as the claim language states "at least one of" [paragraphs 0006, 0018, 0038, 0041, 0043]. Further, it is inherent that the communication device subsequently selects a core network.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 571-272-7841. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EAG/

April 14, 2008

/Erika A. Gary/

Primary Examiner, Art Unit 2617